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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,597	07/20/2001	Emiko Sekimoto	09792909-5093	3291

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EXAMINER

GRAYBILL, DAVID E

ART UNIT PAPER NUMBER

2827

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,597

Applicant(s)

SEKIMOTO, EMIKO *ur*

Examiner

David E Graybill

Art Unit

2827

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

In the rejections infra, reference labels are generally recited only for the first recitation of identical claim language.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1, 3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Arai (5686758).

At column 9, line 64 to column 10, line 62, Arai teaches the following:

1. A package for containing semiconductor element comprising: a package 45 having a recess portion 31, 32 for containing a semiconductor element; and a pair of positioning holes 53 and a pair of attaching holes 52 respectively provided at a pair of opposed side portions of said recess portion at a surface of said package, wherein a line connecting said pair of positioning holes and a line connecting said pair of attaching holes are intersected with each other substantially at a center of said package.

3. A semiconductor device comprising: a semiconductor element 40; a package having a recess portion for containing said semiconductor element; and a pair of positioning holes and a pair of attaching holes respectively provided at a pair of opposed side portions of said recess portion at a surface of said package; wherein a line connecting the pair of positioning holes and a line connecting said pair of attaching holes are intersected with each other substantially at a center of said package.

5. A semiconductor device comprising: a semiconductor element; a package having a recess portion for containing said semiconductor element; a pair of attaching holes provided at a pair of opposed side portions of said recess portion at a surface of said package; and a transparent member 48 for sealing said semiconductor element in said recess portion; wherein said surface of said package is made to be higher than a top surface of said transparent member.

To further clarify the teaching of a transparent member, the member inherently allows the passage of radiation; for example, infrared radiation, therefore, it is transparent.

To further clarify the teaching that the surface of the package is made to be higher than a top surface of the transparent member, it is noted that the scope of the claims is

not limited to a particular frame of reference. In addition, the surface of the package abuts and extends beyond a surface of the transparent member. Therefore, it is inherent that there is a frame of reference wherein the abutting surface of the transparent member is a top surface, and the further extending surface of the package is made to be higher than the top surface.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arai as applied to claims 1, 3 and 5, and further in combination with Kondoh (5448114).

Arai does not appear to explicitly teach the following:

2. The package according to 1: wherein said semiconductor element is a solid-state imaging element.
4. The semiconductor device according to 3, wherein said semiconductor element is a solid-state imaging element.

6. The semiconductor device according to claim 5, wherein said semiconductor element is a solid-state imaging element.

Nonetheless, at column 3, lines 1-13, Kondoh teaches wherein a semiconductor element 1 is a solid-state imaging element, and a transparent member 21. Moreover, it would have been obvious to combine the product of Kondoh with the product of Arai because it would provide a semiconductor element and a transparent member.

The art made of record and not applied to the rejection is considered pertinent to applicant's disclosure. It is cited primarily to show inventions similar to the instant invention.

Any telephone inquiry of a general nature or relating to the status (MPEP 203.08) of this application or proceeding should be directed to Group 2800 Customer Service whose telephone number is 703-306-3329.

Any telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (703) 308-2947. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m.

The fax phone number for group 2800 is 703/3087724.



David E. Graybill
Primary Examiner
Art Unit 2827